REMARKS

The Applicants respectfully submit this Request for Reconsideration in response to the Final Office Action mailed on 06 September 2007, consideration of which is earnestly solicited. In the present Request, no claims have been amended, added, or canceled. Therefore, claims 1-50 as previously presented are pending in the application for reconsideration.

In the Office Action mailed on 06 September 2007, the Examiner rejected claims of the present application under 35 U.S.C. § 103(a) based on Otting et al. (U.S. Patent No. 6,567,663), Bridges et al. (U.S. Patent No. 7,096,015), and Johannesson et al. (U.S. Patent Application Publication No. 2002/0119774). In response, the Applicant respectfully disagrees with the rejections and submits that all pending claims are allowable over the prior art of record for at least the following reasons.

For a proper rejection under 35 U.S.C. § 103(a) the prior art in combination must teach or suggest each and every claimed limitation. In the present case, the prior art in combination fails to teach each and every limitation of the claims.

With respect to claims 1-17, 33-43, and 50, the prior art fails to teach or suggest limitations associated with the performance of actions "if a home communication network of the mobile station is identified as being available, selecting and operating with the home communication network" and "otherwise, if the non-home communication network is identified as being available, selecting and operating with the non-home communication network" which are performed "in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network" or "in response to being powered-on from a power-off state entered while operating with the non-home communication network."

In the Office Action, the Examiner admits that Otting et al. do not disclose the performance of actions "in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network, or in response to being powered-on from a power-off state entered while operating with the non-home

communication network" as claimed. The Examiner also does not employ the Johannesson et al. reference to identify these limitations. However, the Examiner asserts that Bridges et al. disclose these limitations.

In response, the Applicant respectfully disagrees that Bridges et al. disclose the steps of "if a home communication network of the mobile station is identified as being available, selecting and operating with the home communication network" and "otherwise, if the non-home communication network is identified as being available, selecting and operating with the non-home communication network" which are performed "in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network, or in response to being powered-on from a power-off state entered while operating with the non-home communication network" as claimed. In the recited claims of the present application, the Applicant makes use of clear antecedent basis to recite **a** non-home communication network and subsequently **the** non-home communication network, making clear reference to the previously-selected non-home network.

In the argument, the Examiner makes reference to column 12 at lines 25-36 of Bridges et al.. There, Bridges et al. teach the following:

> In FIG. 3, a mobile station enters an initialization state at step S.2, when the mobile station is powered ON, changes systems, is in a "No Service" condition, or when an Intelligent Roaming mode (IR mode) has been selected by the user. After the mobile station has been initialized, the mobile station first scans for its home band (i.e., the set of frequencies corresponding to its home network system) at step S.4 to locate a control channel. The set of frequencies corresponding to the home band of the mobile station may be programmed into the mobile station's memory (e.g. memory 67) by the home system service provider.

Note that the Examiner appears to assume that, prior to performing the steps outlined above, the mobile station of Bridges et al. has been previously operating in a non-home communication network. However, there is no explicit teaching of this in Bridges et al.

If the Examiner is relying on any inherency argument, the argument fails since the Examiner has failed to explain or articulate any basis for such inherency.

Further, the Examiner fails to reference the next passage in column 12 at lines 52-64 which describes further operation of the mobile station in Bridges et al.:

> If the mobile station determines that it is located in its home market area, then at step S.8, the mobile station will stay on that band and obtain service from the home wireless carrier/cellular service provider. *However, if the mobile station determines that it is not in its home market area, then at step S.10 the PSL/IRDB stored in the mobile station will be accessed and searched at step S.12 to determine if the received SID or SOC corresponds to the preferred wireless carrier for the current market area. If the received SID or SOC corresponds to the SID or SOC of the preferred wireless carrier, at S.14 the mobile station 68 obtains service from the current wireless carrier transmitting the received SID or SOC.* (Emphasis Added)

This passage makes clear that, if the home network is unavailable, the mobile station of Bridges et al. operates to select and operate with the *preferred wireless carrier of a Preferred System Identification List (PSL)* – not any non-home communication network with which the mobile station was just previously operating (i.e. just prior to being powered down or out-of-coverage). Again, the Examiner has not met the burden of identifying or articulate any previous non-home network with which the mobile station in Bridges et al. was operating with, prior to being powered down or out-of-coverage, so it is difficult to understand how the teachings in the cited passages of Bridges et al. would possibly teach or suggest the claimed limitations. Again, if the Examiner is relying on any inherency argument, the argument fails since the Examiner has failed to explain or articulate any basis for such inherency.

As explained above, the prior art of record fails to teach or suggest the limitations of the claims 1-17, 33-43, and 50. Therefore, the Applicant respectfully requests the Examiner to withdraw the rejections of claims 1-17, 33-43, and 50 and allow such claims.

Even further, there is no adequate reason that one ordinarily skilled in the art would have to combined the teachings of Otting et al. and Bridges et al. in the manner the

Examiner suggests in the rejecting of claims 1-17, 33-43, and 50. The teachings of Otting et al. primarily focus on network selection techniques for GSM systems. On the other hand, the teachings of Bridges et al. primarily focus on the use of SIDs and SOCs in systems such as IS-136 systems. One ordinarily skilled in the art would appreciate that the technologies as presented are not entirely compatible, as different technology standards (i.e. for network selection) exist for these different systems. One ordinarily skilled in the art would appreciate this and take caution in creating new network selection rules.

In conventional GSM techniques, after recovering from an out-of-coverage condition, a mobile station operates to select the PLMN with which it had just previously registered (i.e. its "RPLMN"). If the RPLMN is unavailable, the mobile station performs a scan to identify and select a PLMN which may be the HPLMN. However, the specifications do not clearly and specifically address the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition, it is specified that the mobile station is limited to selecting the non-home RPLMN (if available) upon recovery. Such conventional operation is described in ETSI specs 3.22/23.122.

Advantageously, the present invention provides an inventive solution to such problem. See page 19 at lines 26-31 of the present application:

> Thus, the above method provides a solution to a problem that the specifications do not clearly and specifically address: the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition or after power-on, the standards specify that the mobile station is limited to selecting the non-home RPLMN (if available).

Note that new independent claim 50 is directed to the particular embodiment as it relates specifically to Global Systems for Mobile Communications (GSM) networks utilizing HPLMNs and RPLMNs.

Thus, since there is no adequate reason that one ordinarily skilled in the art would have to combined the teachings of Otting et al. and Bridges et al. in the manner the

Examiner suggests, such claims are allowable over the prior art of record. The Applicant respectfully requests the Examiner to withdraw the rejections of claims 1-17, 33-43, and 50 and allow such claims.

The prior art of record also fails to teach or suggest the limitations of claims 18-32 and 44-49. The Examiner has also not set forth any proper rejection for the teaching of the limitations of these claims.

In the rejection of claims, the Examiner attempts to describe how the references teach or suggest the limitations of the claims. To illustrate, the Examiner states in part that the references disclose:

> ...performing the following acts of: if a second communication network of the mobile station is identified as being available selecting and operating with the second communication network otherwise, if the non-home communication network is identified as being available selecting and operating with the first communication network (Col. 7, lines 1-45; Col. 9, lines 27-32; Col. 15, line 64-Col. 16, line 8; and Col. 17, line 66-Col. 18, line 45 of Bridges et al.)
>
> Otting et al. and Bridges et al. do not specifically disclose the act of selecting a public land mobile network to serve a mobile station includes the step of receiving at the mobile station a list of data associated with networks neighboring the PLMN currently serving the mobile station after an expiration of a predetermined time period...

The Applicant submits that the rejections as provided for these claims (as in the above passage) fail to properly characterize the limitations as claimed and the asserted teachings. The Examiner has either misread or misunderstood the limitations in the claims, even having mixed up the "first", "second", "non-home", and "home" networks as claimed. Even if, for example, the term "second" network was replaced with the term "home" network in the Examiner's assertions, this would not properly recite the limitations as claimed. The Examiner has even failed to identify any teaching of "if the non-home communication network is unavailable and the home communication network is also unavailable, causing a list of available communication networks to be displayed

for a manual network selection procedure for manual network selection and operating with one of the available communication networks."

Thus, the Examiner's rejections and arguments with respect to claims 18-32 and 44-49 fail. It is difficult if not possible for the Applicant to respond to any rejection if the arguments are not properly characterized or formulated. However, the Applicant respectfully submits that the reason for the difficultly is likely because the prior art of record fails to teach or suggest the limitations of claims 18-32 and 44-49, and there is no adequate reason one ordinarily skilled in the art would have combined the teachings of the references as attempted by the Examiner.

As explained previously, an issue associated with the earlier-described problem of prior art techniques relates specifically to claims 18-32 and 44-49. In particular, GSM standards specify that if the last RPLMN is unavailable while the mobile station is in "manual" network selection mode, the mobile station shall camp on any network providing emergency service. This selected network, however, may not be the optimal network with which to operate, especially, for example, if the home network is made available.

The present application is directed further to a solution to this additional problem with manual network selection, and is defined in claims 18-32 and dependent claims 44-49. The prior art of record fails to teach or suggest other steps which occur "in response to regaining signal coverage from an out-of-coverage condition with the manually-selected non-home communication network" or "in response to being powered-on from a power-off state entered while in the manual network selection mode." In particular, the prior art fails to teach the following steps which are utilized after such events: "if the non-home communication network is unavailable and the home communication network is also unavailable: causing a list of available communication networks to be displayed for a manual network selection procedure for manual network selection and operation with one of the available communication networks" and "if the non-home communication network is unavailable but the home communication network is identified as being available: instead of carrying out the manual network selection procedure for the manual

network selection and operation with one of the available communication networks, selecting and operating with the home communication network."

The above-stated and claimed techniques are advantageous, for example, as described on page 22 at lines 1-5:

> Advantageously in FIG. 7, even in a manual selection mode where choices are made by the end user, the mobile station makes the end user aware of recent availability of the home network in a timely and unobtrusive fashion. Overall, the mobile station helps faciliate the selection of the best network for the end user even in the manual selection mode.

Based on the above, the rejection of claims 18-32 and 44-49 should also be withdrawn and the claims should be allowed.

Additional reasons for the further allowability of both the independent and dependent claims are apparent to those of ordinary skill in the art, but are not articulated herein due to the reasons already presented above.

As explained above, the prior art in combination fails to teach, suggest, or render obvious claims 1-50, and therefore such claims are allowable over the over the prior art of record. The Applicant respectfully requests reconsideration of the claims and allowance of the application as all statutory requirements have now been met.

Thank you. Please feel free to contact the undersigned if there are any questions or concerns regarding this submission.

Respectfully submitted,

/John J. Oskorep/

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